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| APPLICATION NO.                                                                                                | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO.       |
|----------------------------------------------------------------------------------------------------------------|-------------|----------------------|-------------------------------|------------------------|
| 10/731,882                                                                                                     | 12/09/2003  | James Rohl           | 279.630US1                    | 6739                   |
| 21186 7590 05/14/2007<br>SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.<br>P.O. BOX 2938<br>MINNEAPOLIS, MN 55402 |             |                      | EXAMINER<br>HAMILTON, ISAAC N |                        |
|                                                                                                                |             |                      | ART UNIT<br>3724              | PAPER NUMBER           |
|                                                                                                                |             |                      | MAIL DATE<br>05/14/2007       | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/731,882

Applicant(s)

ROHL ET AL.

Examiner

Isaac N. Hamilton

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02/19/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-12 and 53-66 is/are pending in the application.
- 4a) Of the above claim(s) 53-56 and 58-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-12, 57 and 64-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. With the election of Invention III in the reply filed on 08/28/06, applicant submitted claims 53-56 and 58-63. Applicant asserts that the newly submitted claims do not have two-way distinction with the previously elected claims. However, in the Office letter mailed 11/17/06, the new claims were shown to have two way distinctness with the elected invention due to a feature which distinguishes it from Invention III. The features were presented as follows: Claims 53 and 54 provide a lubrication dam; Claim 55 provides a location of the lubrication that is  $\frac{1}{4}$  of the total perimeter of the periphery of the die hole; Claim 56 provides a lubricant that is compatible with a chemistry of the sheet; Claim 58 provides a punch guide with no stripper plate; Claim 59 provides actuating the punch upwardly; Claim 60 provides picking the punched electrode layer out of the backside of the die; Claim 61 provides a top surface extends through the die above the second side of the die; Claim 62 provides an aluminum tab portion; Claim 63 provides an electrode layer punched out of the sheet without applying any compression forces on the sheet. Claim 57 was examined with Invention III because Fluorinert fluid is understood to be a fluorinated or partially fluorinated fluid as recited in claim 11. Applicant has not specifically argued which claim does not have two-way distinctness and has only stated that at least some of the newly submitted claims should be examined, however, two-way distinctness exists between all of the claim groups as set forth above.

### ***Drawings***

2. The drawing was received on 02/19/07. This drawing is acceptable.

***Claim Rejections - 35 USC § 102***

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 10, 12, 64 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsubota (5,361,660). Tsubota discloses placing sheet A between punch 3 and die 7, 11; die hole is in the center of element 7, through which punch 3 passes; delivering lubricant via element 21 as shown in figure 1; actuating the punch as shown in figure 2; the element A in figure 2, which is shown passing through elements 7 and 11 is considered to be an electrode layer for a flat capacitor; sheet is aluminum as disclosed in column 4, line 31; aluminum sheets inherently have an aluminum oxide portion due to the sheets exposure to air as evidenced by Frank et al (2,854,074) in column 1, line 27-29; the portions of the aluminum sheet that are exposed to air and have aluminum oxide on them are considered to be distinct portions; the aluminum portion of the sheet is considered to be a distinct aluminum portion; the lubricant is concentrated on the periphery of the die hole where the punch cuts through the aluminum portion as shown in figure 1, and each location about the periphery of the die hole is considered to be a specific location on the periphery of the die hole.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Tsubota in view of Klint et al (3,288,715), hereafter Klint. Tsubota discloses everything as noted above, but does not disclose delivering a partially fluorinated fluid, however, Klint teaches delivering a partially fluorinated fluid in column 2, lines 2-4. It would have been obvious to deliver a partially fluorinated fluid in Tsubota as taught by Klint in order to obtain a bright surface on the fabricated aluminum.

7. Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Tsubota in view of Klint, and further in view of 3M. Tsubota, as modified above, discloses everything, but the partially fluorinated fluid is not Fluorinert fluid, however, 3M teaches the advantages of delivering Fluorinert fluid. It would have been obvious to deliver a Fluorinert fluid in Tsubota and Klint as taught by 3M in order to use a lubricant that does not contribute to ground-level smog formation.

#### ***Response to Arguments***

8. Applicant's arguments filed 02/19/07 have been fully considered but they are not persuasive. Applicant asserts that because the atomized oil apparently covers the interior of the die relatively equally, then Tsubota does not disclose that the lubricant is concentrated to a pre-determined location on the periphery. However, the claim limitations do not preclude other locations on the periphery to be equally concentrated with lubricant besides the pre-determined location. Therefore, although Tsubota discloses that there is lubricant concentrated about the entire periphery, Tsubota discloses the claim limitations because the limitation "concentrated to a pre-determined location on the periphery" does not preclude the entire periphery from being covered with lubricant. Applicant should focus on adding structure from within the elected

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group, or further limitations concerning how the lubricant is concentrated on the periphery of the die hole, such as withdrawn claim 53, could be pursued in a divisional application or in an RCE that explicitly changes the election.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 571-272-4509. The examiner can normally be reached on Monday through Friday between 8am and 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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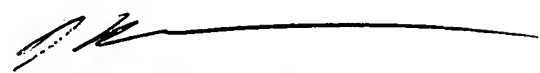
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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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May 8, 2007



KENNETH E. PETERSON  
PRIMARY EXAMINER